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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,731	09/29/2003	William B. Slate	0001-US2	1936
33688	7590	09/08/2005	EXAMINER	
WILLIAM B. SLATE 175 AUSTIN RYER LN. BRANFORD, CT 06405			FRECH, KARL D	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 09/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,731

Applicant(s)

SLATE, WILLIAM B.

Examiner

Karl D. Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's amendment filed 6/24/05 has been entered.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Collins 6,061,681 in view of Romano et al 6,269,366.

Collins discloses a method and appropriate apparatus for accessing photographs of individuals through use of a personal computer 110 including a display 114 over a network 104 connected to at least a local server 106 and a second local server 106, see figure 1A, which contains the information requested at the personal computer 110 in a database 121 on the local server. The user of the system inputs information to search for preferred results. Collins does suggest that this is a "paid" service. Collins does not specifically disclose the celebrity status of the participants. Romano discloses in column 3 lines 7 + that celebrities, sports, movies, political figures and others are contemplated in network searching. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any of a wide variety of genres of persons, items, and events on such a database as that of Collins. This would allow a user to find information on a large variety of different topics. Further, although not specifically disclosed, and since it is old and well known that printers connected to PCs are old and well known, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include a printer in the system of Collins and to

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print out any search results desired in order to provide a hard copy of found information.

Collins and Romano do not specifically disclose the payment or delivery or ordering of the print. However, ordering via the Internet, of a wide variety of items, including pictures, paintings, posters, is old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide for delivery of pictures, etc. in the system of Collins. This would allow a person with a less than adequate printer (due to resolution or size) to "collect" quality pictures. It likewise would have been obvious to a person of ordinary skill in the art to provide a receipt for payment in order to allow the consumer to maintain accounting records. Tax exempt status is not given patentable weight, but it would have been obvious to a person of ordinary skill in the art at the time of the invention to place any relevant information on the receipt. One might provide tax exempt status on the receipt in order to prove to the IRS the applicability of an itemized deduction. Exchanging photographs between people in a photograph is old and well known in the art. It would have been obvious to a person of ordinary skill in the art to exchange photographs in order to allow the other subject of the photograph to also commemorate and occasion; for example, wedding or vacation photos are often exchanged.

4. Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. Applicant argues that no suggestion to combine the references to Collins and Romano was cited. The examiner respectfully disagrees. As seen in the previous rejection, and repeated above, the examiner points out specifically that "Romano discloses in column 3 lines 7+ that celebrities, sports, movies, political figures and others are contemplated in network searching", and that "it would have been obvious to a person of ordinary skill in the art..." to include these "genres of persons, items, and events on such a database as that of Collins." Further applicant acknowledges on page 6 of the response of June 24, 2005 that this "is not believed critical".

7. Applicant argues that neither Romano nor Collins disclose selecting a time designation. The examiner respectfully disagrees. Collins discloses age as a selection. Age, in its broadest interpretation, is a function of time.

8. Applicant argues, regarding claims 2 and 3, that neither Romano nor Collins disclose "accessing an event-specific site or page prior to accessing the list" and "accessing an organization-specific site or page prior to accessing the list." The examiner respectfully disagrees. Collins discloses, in column 3 lines 19-20 for example, accessing the system. That is, Collins discloses accessing a "home page" of a system, before entering the data regarding his/her selection.

9. Applicant does not traverse the rejection of claim 4.
10. Applicant makes a statement about claim 5 but provides no arguments, and therefore does not traverse.
11. Applicant argues that "delivery of said print to a third party who is among the one or more additional persons in the photograph" as in claim 6 is not disclosed by Romano or Collins. However, exchanging photographs is very old and well known as seen above.
12. Applicant makes a statement about claim 7 but provides no arguments, and therefore does not traverse.
13. Applicant argues that no reason for not granting patentable weight to the "tax exempt" feature of claim 8 is provided. The arguments regarding claims 15 and 17 are similar. In response, "tax exempt" status is merely data printed on a receipt. Whether it is tax exempt status of an item or taxable status or sale status, for example, it is still merely data printed on a receipt. However, as clearly seen in the original rejection, and repeated above, although the tax exempt status was not given weight, the examiner did provide reasoning why listing the tax exempt status on a receipt was obvious. The applicant did not argue the examiner's reasoning regarding printing tax exempt status would have been obvious.
14. Applicant argues that Romano and Collins do not disclose "identifying a name of at least one person of the one or more additional ..." as in claim 9. The examiner respectfully disagrees. As seen in figures 3 and 6 of Collins, multiple (at least one additional) people (fig 3) are listed and their name printed (fig 6).

15. Applicant argues that Romano and Collins do not disclose making a selection based upon the time or time period the photograph was taken as in claims 10,19,20. The arguments to claims 16 and 18 are similar. The examiner respectfully disagrees. Applicant is reminded that Romano and Collins form the basis of the obviousness rejection when taken on the whole in combination with the knowledge generally available to one of ordinary skill in the art. One of ordinary skill would have found it obvious to select a given photo based upon time or time period. If one were researching the US Civil War, a photo would be selected from that time period. If one wished to select a photo from last year's birthday party, that time period would be inherently selected. It is inherent that a time period is selected every time a photo is selected, and visa versa.

16. Applicant argues that Romano and Collins do not disclose "information identifying a particular camera or particular photographer or a particular location from a plurality of cameras or photographers or locations at a given event" as in claim 11. The examiner respectfully disagrees. As similar to that seen above, if a person wished to print a photograph of the Grand Canyon, the location of the camera is inherent.

17. Applicant argues that Romano and Collins do not disclose "permitting the user to select the selected public figure form a group of public figures ... printing a first quality photograph ... printing a second quality photograph" as in claim 12. The examiner respectfully disagrees. In column 3 lines 20-25, Romano discloses image enhancement. Thus it is inherent that multiple qualities of photos may be printed.

18. Applicant argues that Romano and Collins do not disclose providing the user with the option of selecting a name to which the public figure is to address the autograph as in claim 13. It is pointed out that it is not claimed that the public figure actually includes this name in the autograph, merely that a user selects a name. Thus, the mere signing of an autograph encompasses this feature, as it is inherent that if the user keeps the photo/autograph that the user selected their own name and if the user gives the photo/autograph to someone else, the user selected the name of another.

19. Applicant argues that Romano and Collins do not disclose the "finite" number of messages as in claim 14. The examiner respectfully disagrees. Applicant does not claim a specific number of messages, only that the possibilities are finite. It is inherent that finite includes any number of messages up to infinite number of messages.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech
Primary Examiner
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